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| 09/773,297 | 01/31/2001 | Thomas J. Walsh | LUT 2 0053 | 6399 |

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EXAMINER

RUTTEN, JAMES D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2122

DATE MAILED: 01/21/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,297

Applicant(s)

WALSH, THOMAS J.

Examiner

J. Derek Ruten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-21 have been examined.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it refers to a joint inventor (page 1 paragraph 3, and page 3 paragraph 2), but only one inventor is indicated and has signed as "Full name of first joint inventor: Thomas J. Walsh". If there is more than one inventor, separate oaths or declarations may be filed, but the other inventors should be mentioned in each oath or declaration. Otherwise, if there is only one inventor, the word "sole" or "only" must appear in place of the word "joint". See MPEP §§ 602: "SOLE OR JOINT DESIGNATION".

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2-7, 13, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. Claim 1 recites the limitation "produced the finding" in line 7. There is insufficient antecedent basis for this limitation in the claim. Although line 6 recites the limitation "produced a finding", the associated method step involved does not deterministically produce a finding that could be referred to in a subsequent method step. In the interest of further examination, this limitation has been interpreted as --produced a finding--.

6. Claims 2-7 are also rejected as being dependent upon a rejected base claim.

7. Claim 2 recites the limitation "produced the observation" in line 4. There is insufficient antecedent basis for this limitation in the claim. Although line 3 recites the limitation "produced an observation", the associated method step involved does not deterministically produce an observation that could be referred to in a subsequent method step. In the interest of further examination, this limitation has been interpreted as --produced an observation--.

8. Claim 6 recites the phrase "setting a status of the finding to resolved" in line 6. The word "resolved" is a verb, but is used here as an adjective. As such, the syntax of the phrase renders the claim indefinite. In the interest of further examination, this limitation has been interpreted as --setting a status of the finding to indicate that it has been resolved--.

9. Claims 13 and 21 have similar issues as discussed in paragraph 8 above, with the use of the word "resolved" in line 4 of each claim. In each of these instances, the phrase "to resolved" will be interpreted as --to indicate that it has been resolved--, as explained above.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. Claims 1-3, 7-10, and 14-18 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent 6,154,753 to McFarland (hereinafter referred to as “McFarland”).

As per claim 1, McFarland discloses a method (column 3 lines 49-50:

“Accordingly, the present invention is directed to a computer implemented system and **method...**”), the method comprising:

documenting, within a database included in a network accessible by the organization and an auditing entity, an activity to be audited; auditing the activity; determining if the audited activity produced a finding; if the audited activity produced the finding, documenting the finding within the database (column 10 lines 34-42: “Referring to FIG. 7, the audit management module 20 includes a single **database** that **plans**, executes, and **records** internal process audits, configuration management audits, and **external 3rd party audits**. As shown at block 150, the audit management module generates an audit schedule, supports recording of internal and **external auditors findings**, prescribes corresponding pre-formatted forms, retains records in a single bundle, supports corrective action plans, and supports verification of corrective action effectiveness.” This passage

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describes an auditing entity which uses a database to plan an audit, and records a determination of findings produced by performing the audit.); *and automatically transmitting, via the network, a notification of the finding from the auditing entity to the organization* (column 16 lines 2-5: “Automatic notification of task and action item assignment is available assuming that appropriate E-Mail is also activated and the person assigned the task has E- Mail facilities.”).

As per claim 2, McFarland discloses:

determining if the audited activity produced an observation; if the audited activity produced the observation, documenting the observation within the database (column 24 lines 6-9: “The audit planning database offers the ability to design and store checklists for various audits, manage internal audit findings, log **observations**, and automatically manage the internal audit schedule.”); *and automatically transmitting, via the network, a notification of the observation from the auditing entity to the organization* (column 16 lines 2-5 as cited above).

As per claim 3, McFarland discloses *resolving the finding* (column 24 lines 9-14: **implementation** of corrective action plans.).

As per claim 7, McFarland discloses *transmitting a report summarizing the finding, via the network, to a predefined addressee* (column 16 lines 2-5; also column 25 line 44 – column 26 line 15).

As per claim 8, McFarland discloses a *system* (column 3 lines 49-50:

“Accordingly, the present invention is directed to a computer implemented system and method...”);

a network; a client computing device communicating with the network; a server

computing device communicating with the network (column 8 lines 25-30: “In the preferred implementation of the invention, a well known software platform was used, entitled **Lotus Notes**, which is a registered trademark of Lotus Development Corporation.

However, any platform may be used which has code permitting the creation of the **system**, apparatus, and method of the present invention.” Lotus Notes inherently uses a client computing device communicating with a server computing device. Without a server, the client would not be able to fully function.); *and*

a database communicating with the network, the activity to be audited being documented within the database, an auditing entity auditing the activity, if the audited activity produces a finding, the finding being documented within the database (column 9 lines 1-

3: “In the preferred implementation, shared databases are sometimes used, which are contained in a server to be accessible by designated members of an organization.” In this passage, the database is contained in a server which is a network device; also column 10 lines 34-42: “Referring to FIG. 7, the audit management module 20 includes a single **database** that **plans**, executes, and **records** internal process audits, configuration management audits, and **external 3rd party audits**. As shown at block 150, the audit management module generates an audit schedule, supports recording of internal and

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external auditors findings, prescribes corresponding pre-formatted forms, retains records in a single bundle, supports corrective action plans, and supports verification of corrective action effectiveness.” This passage describes an auditing entity which uses a database to plan an audit, and records a determination of findings produced by performing the audit.), *and* *a notification of the finding being transmitted, via the network, from the auditing entity to the organization* (column 16 lines 2-5: “Automatic **notification** of task and **action item** assignment is available assuming that appropriate E-Mail is also activated and the person assigned the task has E- Mail facilities.” Email is inherently transmitted via a network since it is a client/server application.).

As per claim 9, the rejection of claim 8 is incorporated. All further limitations have been addressed in the rejection of claim 2 above.

As per claim 10, the rejection of claim 8 is incorporated. McFarland further discloses resolution of a finding using computers communicating across a network (column 24 lines 9-14: **implementation** of corrective action plans; also column 15 lines 56-57).

As per claim 14, the rejection of claim 8 is incorporated. All further limitations have been addressed in the rejection of claim 7 above.

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As per claim 15, McFarland discloses *A method* (column 3 lines 49-50:

“Accordingly, the present invention is directed to a computer implemented system and method...”),

the method comprising:

identifying an activity to be audited; auditing the activity; and if the audited activity

produces a finding, documenting the finding (column 10 lines 34-37: “Referring to FIG.

7, the audit management module 20 includes a single database that **plans**, executes, and

records internal process audits, configuration management audits, and **external 3rd**

party audits.” This passage describes an auditing entity which uses a database to plan an audit, and records findings produced by performing the audit.).

As per claims 16 and 18, the rejection of claim 15 is incorporated. All further limitations have been addressed in the rejection of claims 2 and 3, respectively, above.

As per claim 17, the rejection of claim 16 is incorporated. All further limitations have been addressed in the rejections of claims 1 and 2 above.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 4-6, 11-13, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McFarland as applied to claims 3, 10, and 18, respectively above, and further in view of U.S. Patent 5,706,452 to Ivanov (hereinafter referred to as "Ivanov").

As per claim 4, McFarland discloses *developing, within the organization, a proposed response for resolving the finding* (column 24 lines 9-14: **development of** corrective action plans.);

McFarland does not expressly disclose *transmitting, via the network, the proposed response to the auditing entity*.

However, in an analogous environment, Ivanov teaches using a workflow manager to send network notification of document status (column 5 lines 25-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Ivanov's network notification system to distribute McFarland's proposed response. One of ordinary skill would have been motivated to use an automatic and efficient notification system.

As per claim 5, the rejection of claim 4 is incorporated, and further, McFarland discloses *determining if the proposed response is acceptable to the auditing entity* (column 13 lines 23-26);

if the proposed response is acceptable, implementing the proposed response at the organization (column 3 lines 12-16; column 24 lines 9-14).

McFarland does not expressly disclose:

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if the proposed response is not acceptable, performing a first negotiation between the organization and the auditing entity to determine a negotiated response;
if the negotiated response is not acceptable to both the organization and the auditing entity, escalating a status of the finding.

However, in an analogous environment, Ivanov teaches a method of document review where a preparer creates a document, a reviewer reviews the document and negotiation ensues until the document is declared “reviewed”, i.e. until both parties agree on the response. If an agreement is not reached, an escalation event occurs. (column 6 lines 6-9; column 7 lines 53-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Ivanov’s document review with McFarland’s audit. One of ordinary skill in the art would have been motivated to define efficient strategies for collective document evaluation.

As per claim 6, the above rejection of claim 5 is incorporated. McFarland further discloses:

determining if the implemented response is acceptable to the auditing entity (column 13 lines 23-26);

if the implemented response is acceptable to the auditing entity, setting a status of the finding to resolved (column 17 lines 48-52);

McFarland does not expressly disclose:

if the implemented response is not acceptable to the auditing entity, performing second negotiations between the organization and the auditing entity; and if the second negotiations do not result in a response acceptable to both the organization and the auditing entity, escalating a status of the finding.

However, in an analogous environment, Ivanov teaches a method of document review as cited in the above rejection of claim 5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Ivanov's document review with McFarland's audit. One of ordinary skill in the art would have been motivated to repeat the defined efficient strategy for collective document evaluation after a first unsuccessful negotiation attempt.

As per claims 11-13 the rejection of claim 10 is incorporated. All further limitations have been addressed in the above rejections of claims 4-6.

As per claim 19, the rejection of claim 18 is incorporated. All further limitations have been addressed in the above rejections of claims 1, 4, and 5.

As per claim 20, the rejection of claim 19 is incorporated. McFarland discloses the use of email for sending reports to all related parties (column 15 lines 56-57). All further limitations have been addressed in the above rejections of claims 1 and 4.

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As per claim 21, the rejection of claim 19 is incorporated. All further limitations have been addressed in the above rejection of claim 6.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 5,495,412 to Thiessen discloses a method for computer assisted negotiation using a communication link.

“IEEE Standard for Software Reviews and Audits”, published by IEEE discloses general guidelines for audits including finding resolution, follow-up actions, and resolution approval (pages 22 and 31).

“Software Quality Assurance – Concepts and Misconceptions” by Runeson and Isacson, discloses SQA as relating to CMM and ISO 9001 including finding resescalation and escalation (page 858, Sections 4.2 and 4.3).

“Software Development Process Standards: Challenges for Process Assurance” by Smith discloses audit reports and resolution approval (page 183 column 1).

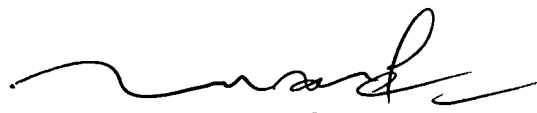
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Derek Rutten whose telephone number is (703) 605-5233. The examiner can normally be reached on M-F 6:30-3:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703)305-4552. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-5484.

jdr



TUAN DAM
SUPERVISORY PATENT EXAMINER